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SEP 01 2005

OFFICE OF PETITIONS

In re Application of :
John F. Stoops et al :
Application No. 10/786,514 : DECISION GRANTING PETITION
Filed: February 24, 2004 : UNDER 37 CFR 1.313(a)
Attorney Docket No. 7616-US :
:

This is a decision on the petition under 37 CFR 1.313(a), filed June 20, 2005, to withdraw the above-identified application from issue.

The petition is DISMISSED.

Petitioner requests that the present application be withdrawn from issue for consideration of a concurrently filed reference listed in an IDS; namely, a reference cited by an opponent in a lawsuit involving U.S. Patent No. 5,124,597.

37 CFR 1.313(a) states, in part:

Applications may be withdrawn from issue for further action at the initiative of the Office or upon petition by the applicant. To request that the Office withdraw an application from issue, applicant must file a petition under this section including the fee set forth in § 1.17(h) and a showing of good and sufficient reasons why withdrawal of the application is necessary.

As such, a grantable petition requesting withdrawal of an application from issue must be accompanied by: (1) a showing of good and sufficient reasons why withdrawal of the application from issue is necessary; and (2) the requisite petition fee under 37 CFR 1.17(h). The petition fee of \$130 has been charged to petitioner's deposit account. Additionally, as authorized in the petition, the \$180 fee required under 37 CFR 1.17(p) for consideration of the IDS will be charged to petitioner's deposit account.

However, the petition does not set forth good and sufficient reasons as to why withdrawal of the application is necessary. The mere submission of an IDS with the petition does not make withdrawal of the application from issue necessary. There are other avenues open to applicant to have an IDS considered other than by way of petition.

Following the part of 37 CFR 1.313(a) cited above, 37 CFR 1.313(a) goes on to state:

A petition under this section is not required if a request for continued examination under § 1.114 is filed prior to payment of the issue fee.

The filing of a request for continued examination (RCE) under 37 CFR 1.114 with a submission and the fee set forth in 37 CFR 1.17(e) would have been a proper available option to have the IDS considered. It is well documented that an IDS satisfies the submission requirement under 37 CFR 1.114. See MPEP 706.07(h) (II).

For the above reasons, this application will not be withdrawn from issue under the provisions of 37 CFR 1.313(a).

The issue fee in this application was received on June 20, 2005. If the IDS is not favorably considered by the examiner, petitioner may wish to file a petition under 37 CFR 1.313(c)(2).

Any inquiries regarding this decision should be directed to the undersigned at (571) 272-3218.

This matter is being referred to Technology Center AU 2816 for appropriate action on the IDS filed June 20, 2005.


Frances Hicks
Petitions Examiner
Office of Petitions